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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,337	01/20/2000	Evgeniy M. Getsin	IACTP010	4283

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EXAMINER	
AVELLINO, JOSEPH E	
ART UNIT	**PAPER NUMBER**
2143	

DATE MAILED: 05/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/488,337	GETSIN ET AL.	
	Examiner	Art Unit	
	Joseph E. Avellino	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

TR

DETAILED ACTION

1. Claims 1-24 are presented for examination; claims 1, 7, 13, and 19 independent.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 13-18 are rejected under 35 USC 101 as not being tangibly embodied.

The aforementioned claims recite a system however only compromise logic.

Furthermore this logic is not tangibly embodied on a computer readable medium.

Correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The aforementioned claims recite a system however only recite logic, which is not a tangible embodiment of a system. A system requires at least one piece of hardware. Correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. (hereinafter Roberts) (USPN 6,161,132) in view of Rust (USPN 6,535,909).

6. Referring to claims 1, 7, and 13, Roberts discloses a method for storing synchronization information for subsequent playback of an event on a plurality of client apparatuses, comprising the steps of:

providing an event stored in memory on at least one of the client apparatuses, wherein the client apparatuses and a host computer (server) are adapted to be connected to a network (Internet) (col. 7, line 30 to col. 8, line 2);

storing information on the host computer for allowing the simultaneous playback of the event from the memory on each of the client apparatuses (col. 7, line 30 to col. 8, line 2);

Roberts does not disclose storing content and timing information transmitted during the simultaneous playback of the event at the host computer, and allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous

playback. In analogous art, Rust discloses another method for storing synchronization information comprising the steps of:

storing content and timing information (i.e. archiving) transmitted during the simultaneous playback of the event at the host computer (e.g. abstract; Figures 2-6; col. 6, lines 28-40); and

allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback (e.g. abstract; Figures 2-6; col. 6, lines 41-65).

It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Rust with Roberts to allow the attendee to experience the presentation again, in order to more fully absorb the content, as well as to allow someone who was unable to attend the presentation to allow them to get up to speed with the critical information, thereby increasing customer service and allowing the proper disclosure of information to those required to view it as supported by Rust (col. 2, lines 6-31).

7. As to claims 2, 8, and 14, Roberts-Rust discloses the invention substantially as discussed in the claim 1 rejection, including the event includes a video and audio presentation (Roberts, col. 2, lines 5-26).

8. As to claims 3, 9, and 15, Roberts discloses a method for storing synchronization information as stated above. Roberts does not disclose the information includes a

history and data associated with the simultaneous playback. Rust discloses the information includes a history and data associated with the simultaneous playback (event log) (col. 7, lines 47-50). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Rust with Roberts to allow the attendee to experience the presentation again, in order to more fully absorb the content, as well as to allow someone who was unable to attend the presentation to allow them to get up to speed with the critical information, thereby increasing customer service and allowing the proper disclosure of information to those required to view it as supported by Rust (col. 2, lines 6-31).

9. As to claims 4, 10, and 16, Roberts-Rust discloses the invention substantially as discussed in the claim 1 rejection, including the network is a wide area network (Roberts, col. 1, lines 57-61). The Office takes the Internet to be synonymous with a wide area network.

10. As to claims 5, 11, and 17, Roberts-Rust discloses the invention substantially as discussed in the claim 1 rejection, including the memory includes a digital video disc (DVD) (Roberts, col. 2, lines 5-18).

11. As to claims 6, 12, and 18, Roberts-Rust discloses the invention substantially as discussed in the claim 1 rejection, including the information includes chapter information associated with the DVD (Roberts, col. 4, lines 1-20). The term "track" can be

considered equivalent to a chapter on a DVD since DVD movies are segmented into chapters such as audio CD's are segmented into audio tracks.

12. Claims 19-24 are rejected for similar reasons as stated above.

Response to Amendment

13. The affidavit filed on April 12, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Rust reference.

14. The Office points out to Applicant that "the affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.")". See MPEP 715.07.

15. Applicant has not provided evidence to the Office which supports the claim. The It is unable to be ascertained by the Office as to what features of the Exhibits Applicant is relying upon in order to prove reduction to practice prior to November 18, 1999. The Exhibits do not provide evidence regarding the specific limitations covered by Rust. For example it is unable to be determined how the Exhibits disclose the limitation of "storing information on the host computer for allowing a simultaneous playback of the same event from the memory on each of the client apparatuses" (claim 1).

16. Furthermore, Applicant has stated in the declaration that the invention was "manufactured and tested prior to November 18, 1999" (point 3) thereby providing reduction of practice prior to the filing date of Rust. Applicant is advised that "proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose." See MPEP 715.07(III). Applicant's Exhibits provided that a chat session with John Frankenheimer will occur. No documentary evidence has been provided that the chat session ever occurred prior to November 18, 1999. Furthermore the Exhibits further disclose that "the users can log back on to the website at a later date to re-experience the entire event or see it for the first time, in case they missed it." However evidence that "allowing the content and timing information to be downloaded utilizing the network for playback of said event and said downloaded content and timing information after the simultaneous playback" is lacking evidence that it *successfully worked*. Applicant is requested to provide evidence that the chat session

did, in fact, occur prior to November 18, 1999 and a successful download of the chat session was executed prior to this date as well.

17. Furthermore, Applicant has not indicated in the declaration that the Exhibits provided are Applicant's own invention. It is not clear form the Exhibits that this is the Applicant's own invention. The Office is not suggesting that Applicant is using evidence of another's work, rather that this statement is lacking in the declaration.

18. For the reasons above, the Declaration is considered to be ineffective in overcoming the Rust reference.

19. Applicant argues, in substance, that (1) a 35 USC 135 rejection should have been given instead of a 35 USC 103 rejection for being drawn to a same patentable invention.

20. As to point (1) Applicant is advised that a 35 USC 135 rejection only pertains to "a claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application *unless such a claim is made prior to one year from the date on which the patent was granted*". The Rust patent is less than one year from the filing date of the application. Therefore, a rejection under 35 USC 103 is proper.

Request for Information 37 C.F.R. 1.105

21. Applicant and the Assignee of this application are required under 37 CFR §1.105 to provide the following information that the Examiner has determined is reasonably necessary for proper examination of this application. The information is required to identify goods, products, and/or services encompassing the claimed subject matter in any/all of the instant pending claims which is/was owned, operated, or licensed by the current Assignee or any one member of the inventive entity, and identify and compare the properties of similar goods, products, and/or services found in the prior art.

22. In response to this requirement, please provide information of the earliest dates of any other public demonstrations (if they exist) of the invention which is encompassed by any one of the currently pending claims in the instant application.

23. In response to this requirement, please provide information related to the earlies date as to when this invention was known or used by others, specifically when this invention was licensed to be used by, or sold to MGM Home Entertainment as suggested by the Applicant's Exhibits of the Declaration dated April 12, 2005.

24. Please refer to MPEP §704.11(a) and 37 C.F.R. §§1.105(a)(i)-(vii) for further explanation of this requirement, if necessary, in order to constitute a proper reply for

response to this request(s). It is noted MPEP §704.12 specifically recites what constitutes proper and improper replies to this requirement.

25. Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR §1.56. Where the Applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEA
April 21, 2005

WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER